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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,900	10/25/2001	Peter Worthington Hamilton	8762	7654

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EXAMINER

SIMONE, CATHERINE A

ART UNIT PAPER NUMBER

1772

DATE MAILED: 01/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/003,900

Applicant(s)

HAMILTON ET AL.

Examiner

Catherine Simone

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9 and 10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Withdrawn Rejections

1. The Double Patenting rejection of claims 1-20 of record in Paper #8, Pages 4-5, Paragraph #5 has been withdrawn due to the Applicants arguments in Paper #13.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over McGuire et al. (5,965,235).

Regarding **claims 1 and 2**, McGuire et al. discloses a storage wrap material comprising a sheet material having a thickness ranging from about 0.0001 inches (0.0025 mm) to 0.001 inches (0.025 mm) (see col. 21, line 55 and col. 23, line 25), the sheet material having a first active side and a second side (see col. 3, lines 1-10), the first active side comprising a plurality of three-dimensional non-adherent protrusions (Fig. 9, #12) extending outwardly from surrounding depressions (Fig. 9, #14) and an adhesive composition coating on at least a portion of the depressions (Fig. 9, #16). McGuire et al. teaches the adhesive coating composition having a thickness less than the height of the non-adherent protrusions and preferably about 0.001 inch (0.025 mm) thick and even more preferably between about 0.0005 inch (0.013 mm) and 0.002 inch (0.051 mm)(see col. 17, lines 30-

45). However, McGuire et al. fails to teach the specific ranges for the thickness of the adhesive coating composition as recited in claims 1 and 2 of the present invention. The thickness of the adhesive coating composition would be readily determined through routine experimentation by one having ordinary skill in the art depending on the desired end results. There is no indication in McGuire et al. that the thickness of the adhesive coating composition cannot be in the range from about 0.00001 inches (0.00025 mm) to about 0.0002 inches (0.0051 mm). Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have the adhesive coating composition with a thickness from about 0.00001 inches (0.00025 mm) to about 0.0002 inches (0.0051 mm), since it has been held that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). Regarding **claims 5 and 6**, the adhesive composition coating covers less than 75% of the first active side of the sheet material (see col. 20, lines 1-5). Regarding **claims 7-9**, note the first active side is activatable by an externally applied force exerted upon the sheet material (see col. 16, lines 63-67 and col. 17, lines 1-4). Regarding **claim 12**, note the second side comprises an active side (see col. 3, lines 7-10). Regarding **claim 15**, the sheet material comprises a polymeric film material (see col. 17, lines 56-60).

Regarding **claims 16-20**, process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). This burden is NOT

discharged solely because the product was derived from a process not known to the prior art. *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitations in claims 16-20 are methods of production and therefore do not determine the patentability of the product itself.

Response to Amendment

4. The declaration under 37 CFR 1.132 filed November 4, 2003 is insufficient to overcome the 35 U.S.C. 103 rejection of claims 1-20 based upon the McGuire et al. reference as set forth in the last Office because the declaration fails to set forth facts. The declaration is merely drawn to Applicant's opinion of the prior art cited by the Examiner. There is no showing of unexpected results. To establish unexpected results over a claimed range, applicants should compare a sufficient number of tests both inside and outside the claimed range to show the criticality of the claimed range. *In re Hill*, 284 F.2d 955, 128 USPQ 197 (CCPA 1960). Furthermore, the examples in the Declaration are of no probative value in determining patentability of claims since they do not involve a comparison of Applicant's invention with the closest applied prior art. See *In re De Blawe*, 222 USPQ 191 (Fed. Cir. 1984), and *In re Fenn*, 208 USPQ 470 (CCPA 1981).

Conclusion


5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Simone whose telephone number is (571)272-1501. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-0987.


Catherine Simone
Examiner
Art Unit 1772
January 13, 2004


HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

1/23/04